

## REMARKS

This Amendment is intended as a full and complete response to the final Office Action dated July 25, 2006. In the Office Action, the Examiner states that claims 1-18 are pending and stand rejected. By this Amendment, claims 1-18 continue unamended.

In view of both the amendments presented above and the following discussion, the Applicants submit that none of the claims now pending in the application are anticipated or obvious under the provisions of 35 U.S.C. § 102 and § 103. Thus, the Applicants believe that all of these claims are now in allowable form.

## Rejections

### A. 35 U.S.C. § 102

Claim 17 stands rejected under 35 U.S.C. §102 as being anticipated by US Patent No. 6,247,626 to MacVicar. The rejection is respectfully traversed.

Independent claim 17 recites:

An explosion-driven setting tool, comprising a setting mechanism (12) driven by a propellant (23); ignition means (18) for igniting the propellant (23); a receptacle (15) for receiving a propellant holder (20) which has a housing (21) with an interior space (22) for receiving propellant (23), and a data storage identification unit (40) in which a propellant supply level (27) is stored for being read-out; a display (50) for displaying the propellant supply level (27); a data communication interface (31) for receiving identification data read-out from the data storage identification unit (40); and a data processing unit (30) for receiving the identification data from the data communication interface (31) and connected with the display (50) for communicating the propellant supply level (27) thereto. (emphasis added).

As a preliminary matter, we believe that it would be helpful to review the appropriate standard under 35 U.S.C. § 102 for analyzing the features of a claim with respect to the prior art. It is well settled that “[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim” (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis

added). The MacVicar patent fails to disclose each and every element of the claimed invention, as arranged in the claim.

The MacVicar patent discloses “[d]ata input signals may also be provided to microprocessor 300 by a user-interface module and/or from an external computer via communications/download module” (see MacVicar, col. 16, lines 58-61 and FIG. 39A, including the note to FIG. 39A). By contrast, the Applicants’ invention claims “a data storage identification unit (40) in which a propellant supply level (27) is stored for being read-out; a display (50) for displaying the propellant supply level (27); a data communication interface (31) for receiving identification data read-out from the data storage identification unit (40); and a data processing unit (30) for receiving the identification data from the data communication interface (31) and connected with the display (50) for communicating the propellant supply level (27) thereto.”

The fuel control circuit of FIG. 17 of MacVicar is provided in the MacVicar tool to regulate the flow of liquefied petroleum gas to the combustion chamber. Referring to FIG. 17, the fuel control circuit includes an infrared isolation stage, a fuel valve driver and a fuel valve. Further, a metering solenoid valve 46 delivers a precise amount of fuel to the combustion chamber 12 prior to ignition. (see MacVicar, col. 6, lines 29-35 and col. 13, lines 33-38). Nowhere in the MacVicar patent is there any teaching that the fuel control circuit of FIG. 17 stores data and functions as a data storage identification unit. Therefore, the MacVicar patent fails to disclose each and every element of the claimed invention, as arranged in the claim.

As such, it is submitted that independent claim 17, is not anticipated and fully satisfies 35 U.S.C. §102 and is patentable thereunder. Therefore, it is respectfully requested that the claim rejection be withdrawn.

B. 35 U.S.C. § 103

1. Claims 1-3, 6, 7, 10-13, 15, 16 and 18

Claims 1-3, 6, 7, 10-13, 15, 16 and 18 stand rejected under 35 U.S.C. §103 as being obvious over US Patent No. 6,247,626 to MacVicar in view of US Patent No.

6,722,550 to Ricordi et al (hereinafter “Ricordi”) and in further view of US Patent No. 6,789,421 to Gore et al (hereinafter “Gore”). The rejection is respectfully traversed.

As a preliminary matter, we believe that it would be helpful to review the appropriate standard under 35 U.S.C. § 103 for analyzing the features of a claim with respect to the prior art. It is well settled that [t]he test under 35 U.S.C. § 103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). The combination of the cited art fails to teach or suggest the Applicant’s invention as a whole.

It is submitted that US Patent No. 6,722,550 to Ricordi is not a prior art reference. In particular, the present application claims priority to German patent application No. 10319646.3, which was filed May 2, 2003. The claim for foreign priority to the above-identified German patent application was set forth in the Declaration, which was filed on April 22, 2004 as part of the original US patent application.

As an English translation of German patent application No. 10319646.3, along with a certified statement that the translation is accurate is attached herewith, priority to the German patent application No. 10319646.3 is claimed under 35 U.S.C. § 119 and 37 C.F.R. § 1.55. As such, it is submitted that the German priority Application is to be considered in the same manner as if it had been filed in this country on the same date that it was filed in the foreign country (i.e., Germany), that is, May 2, 2003. (See also MPEP 201.15)

The Ricodi patent application was later filed May 9, 2003 in the USPTO and issued on April 20, 2004 as a US patent No. 6,722,550, and does not have an earlier effective filing date or priority date. As such, the effective filing date (i.e., priority date) of the present application under 35 U.S.C. § 119 and 37 C.F.R. § 1.55 is May 2, 2003, which is before the earliest effective filing date of the Ricodi patent. Therefore, it is respectfully submitted that the Ricodi patent should no longer be considered as a prior art patent against the present Application.

Further, even if the Ricodi patent is somehow deemed an appropriate reference, there would have not been any motivation for someone skilled in the art to combine MacVicar, Ricodi and Gore, since Ricodi fails to disclose “a data storage identification unit (40) affixed to said housing (21) and in which a propellant supply level (27) is stored for being read-out by the data communication interface (31) of the setting tool.”

Moreover, Gore discloses an anode reservoir for an electrical energy producing fuel cell in which methanol, which is not a propellant for setting tools, is to be stored. The object of Gore is to provide “a convenient, cost efficient means for determining the amount of fuel remaining in the fuel cell” (see Gore, col. 2, line 4). Conversely, the object of the present invention is to easily ascertain the number of remaining propellant charges (see Specification, page 4, last paragraph).

Gore merely suggests the use of a density-based fuel indicator, like a float, located on a side of the reservoir (see Gore, col. 4, lines 30-46). Such an indicator would not be visible to the user of a setting tool, when such a reservoir is located in the receptacle of a dispenser (see also Specification, page 4, second paragraph). Further, Gore merely visualizes the percentage of fuel remaining in the reservoir, but fails to provide indicia of the number of remaining propellant charges.

Moreover, the indicator of Gore does not provide for any data communication between the reservoir and the fuel cell. That is, although Gore discloses a vertical window 204 visible from the exterior of the fuel cell, and a fuel scale 206 affixed to the exterior of the fuel cell extending along the vertical length of the window 204 (Gore, col. 3, lines 1-9), there is no motivation, suggestion or teaching that the data communications interface of the setting tool will read out the fuel level from the fuel cell of Gore. That is, the Applicants’ claimed invention includes “a data storage identification unit (40) affixed to said housing (21) and in which a propellant supply level (27) is stored for being read-out by the data communication interface (31) of the setting tool.” The combination of MacVicar and Gore would not motivate a person skilled in the art towards the Applicants’ claimed invention, and therefore fails to teach or suggest the invention as a whole.

As such, it is submitted that independent claim 1, and similarly, independent claim 10 are not obvious and fully satisfy 35 U.S.C. §103 and are patentable thereunder.

Furthermore, claims 2, 3, 6, 7, 11-13, 15, 16 and 18 depend, either directly or indirectly, from independent claims 1 and 10 and recite additional features of the invention. As such, it is submitted that these dependent claims are also not obvious and fully satisfy 35 U.S.C. §103 and are patentable thereunder. Therefore, it is respectfully requested that the claim rejections be withdrawn.

2. Claims 4, 5 and 14

Claims 4, 5 and 14 stand rejected under 35 U.S.C. §103 as being obvious over US MacVicar in view of Ricordi and Gore, and in further view of US Patent Application Publication No. 20010045892 to Thomas et al (hereinafter “Thomas”). The rejection is respectfully traversed.

Dependent claims 4, 5 and 14 are directed to further defining the data communication interface as being formed by an antenna. These dependent claims include all of the limitations of their respective independent claims and any intermediate dependent claims. For example, dependent claim 4 recites:

"A propellant holder according to Claim 2, wherein the data communication interface (41) is formed as an antenna."

As discussed above, the cited Ricordi patent is no longer considered prior art against the present invention. MacVicar discloses an internal combustion powered tool that includes a control circuit, such as a microprocessor, for controlling various parameters of the power tool. The control circuit is a component of the tool, as opposed to being a component of the propellant holder. Nowhere in the MacVicar patent is there any teaching or suggestion of the claimed feature “a data storage identification unit (40) affixed to said housing (21) and in which a propellant supply level (27) is stored for being read-out by the data communication interface (31) of the setting tool.” The fuel control circuit as shown in FIG. 17 of MacVicar is used to regulate the flow of fuel to the combustion chamber, as opposed to storing data that can be read-out by the data communication interface of the setting tool.

As also discussed above, there is no motivation to combine Gore with MacVicar, since the indicator of Gore indicator would not be visible to the user of a setting tool, when such a reservoir is located in the receptacle of a dispenser. Furthermore, the Thomas patent fails to bridge the substantial gap as between the MacVicar and Gore patents and the claimed invention. In particular, Thomas discloses a wireless gauge alert system having a remote assembly and a receiver unit. The remote assembly includes a pressure gauge, transmitter and antenna for transmitting wireless signals indicating pressure readings to the receiver unit. (See Thomas, Abstract and page 2, paragraph 0031 and FIGS. 1-5).

The Thomas patent fails to teach or suggest that the data storage identification unit (40) is affixed to the housing of the propellant holder. Rather, Thomas merely discloses that a fuel level detector that includes an output member, a linkage arm assembly, lever arm, buoy and counter balance are attached to a fuel tank. (see Thomas, page 2, paragraph 0023). It is important to note that the measuring device of the Thomas patent is not the same as the data storage identification unit (40) of the Applicants' invention.

In particular, the measuring device of Thomas is an analog device used for large sized propellant tanks which includes a buoy which floats on the surface of the liquid fluid, and moves up and down as the fluid in the tank is either increased or consumed. The buoy is connected to the linking arm that interfaces with the fuel gauge. By contrast, the Applicants data storage identification unit is a memory device that stores (i) identification information about the propellant, such as the type of propellant, and (ii) supply level data.

Even if the remaining three patents could somehow be operably combined (and the Applicant submits that the three patents cannot be operably combined, since the measuring device 24 of Thomas cannot be operably incorporated into or used with the power tool of MacVicar and Gore, and one skilled in the art would not look to the teachings of Thomas to include wireless transmissions in a hand-held power tool), the combination of MacVicker, Gore and Thomas fails to teach or suggest "a propellant holder adapted for being removably installed in said setting tool" and "a data storage

identification unit (40) affixed to said housing (21).” Accordingly, the combination of the cited patents fails to teach or suggest the Applicant’s invention as a whole.

As such, the Applicant submit that dependent claims 4, 5 and 14 are not obvious and fully satisfy 35 U.S.C. §103 and are patentable thereunder. Therefore, it is respectfully requested that the claim rejections be withdrawn.

## CONCLUSION

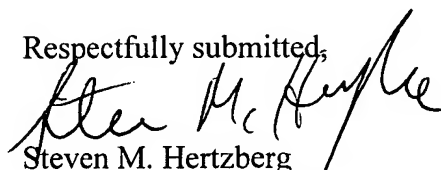
In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue.

Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned at (212) 885-9223 so that the appropriate arrangements can be made for resolving such issues as expeditiously as possible.

The Commissioner is hereby authorized to charge any fees, or to credit any overpayment, due by reason of this Amendment to Deposit Account No. 01-0035.

Respectfully submitted,



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